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OFFICE OF PETITIONS

ON PETITION

In re Application of :
Diener et al. :
Application No. 10/615,771 :
Filed: July 10, 2003 :
Attorney Docket No. PF51471-02 :

This is a decision in response to the papers filed September 13, 2004, which are being treated as a petition requesting, in effect, that pages 3 and 11 filed on September 13, 2004, be entered as part of the original disclosure.

The petition is **dismissed**.

The application was filed on July 10, 2004.

On September 13, 2004, the Office of Initial Patent Examination mailed a "Notice of Omitted Item(s)" stating that the application had been accorded a filing date of July 10, 2003, and advising applicants that pages 3 and 11 of the specification appeared to have been omitted.

In response, the present "petition" was filed. Petitioner has filed a copy of pages 3 and 11 of the specification. However, petitioner has not alleged the missing pages were filed on July 10, 2003, and has supplied no evidence the papers were filed on July 10, 2003. Therefore, the pages cannot be entered.

As a courtesy, the Office notes the transmittal letter appears to include language incorporating by reference the content of the parent application.

The Office allows an applicant to rely upon an incorporation by reference of a parent application when a portion of the child application has been inadvertently omitted. MPEP 201.06(c) states that:

... an applicant may incorporate by reference the prior application by including, in the application-as-filed, a statement that such specifically enumerated prior application or applications are "hereby incorporated herein by reference." The statement may appear in the specification or in the application transmittal letter. The inclusion of this incorporation by reference of the prior application(s) will permit an applicant to amend the continuing application to include any subject matter in such prior application(s), without the need for a petition provided the continuation or divisional application is entitled to a filing date notwithstanding the incorporation by reference. . . .

If a continuation or divisional application as originally filed is entitled to a filing date despite the omission of a portion of the prior application(s), applicant will be permitted to add the omitted material by way of an amendment provided a statement was included in the application as originally filed that incorporates by reference the prior application(s). If the application as originally filed includes a proper incorporation by reference of the prior application(s), an omitted specification page(s) and/or drawing figure(s) identified in a "Notice of Omitted Item(s)" may be added by amendment provided the omitted item(s)

contains only subject matter in common with such prior application(s). In such case, applicant need not respond to the "Notice of Omitted Item(s)." Applicant should submit the amendment adding the omitted material prior to the first Office action to avoid delays in the prosecution of the application. See MPEP § 601.01(d) and § 601.01(g).

An amendment to the specification deleting references to the missing pages should be filed prior to the first USPTO action in order to avoid further delays in the examination of the application. *In the alternative*, if petitioner desires for the examiner to consider pages which were not submitted as part of the original disclosure, then petitioner may seek to submit some or all of those pages as an amendment. Any such amendment will, of course, be reviewed by the examiner for new matter. See MPEP 608.02(a).

The pages submitted with the petition will not be entered. Should petitioner wish for the pages to be entered, an amendment must be filed.

The original application papers will include only those application papers present on the date of deposit.

Since the present petition was not necessitated by any error on the part of the Office, the \$130.00 petition fee will not be refunded.

The Office of Initial Patent Examination will be informed of the instant decision.

Telephone inquiries should be directed to Petitions Attorney Steven Brantley at (571) 272-3203.



Charles Steven Brantley
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Office of Petitions